



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,756	04/13/2006	Hiroyoshi Kato	1691-0218PUS1	6847

2292 7590 10/31/2007
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
----------	--------------

1793

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

10/31/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/575,756

Applicant(s)

KATO ET AL.

Examiner

Anthony J. Green

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/13/06 & 7/14/06</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 provides for the use of calcium hydroxide particles, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 5 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Art Unit: 1793

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. JP 58-017816A.

The reference teaches a slurry of a metal hydroxide such as calcium hydroxide wherein the particle size of the metal hydroxide is 1-1000 microns.

The instant claims are met by the reference as the reference anticipates the instant claims at the lower limit of the recited range of the reference (i.e. from 1 to 3 microns). While the reference does not recite that the composition is a cement setting accelerator, it is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

6. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Butters et al (US Patent Application Publication No. US 2004/0129175 A1).

The reference teaches, in the abstract, the examples and the claims, a calcium hydroxide slurry having a mean particle size of 0.2 to 50 microns.

The instant claims are met by the reference as the reference anticipates the instant claims at the lower limit of the recited range of the reference (i.e. from 0.2 to 3 microns). While the reference does not recite that the composition is a cement setting accelerator it is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d. 2109, 169 USPQ 226 (CCPA 1971).

7. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin (US Patent No. 5,518,980 A).

The reference teaches, in column 5, lines 25+, calcium hydroxide slurries having an average primary particle size of about 0.05 to 5.0 microns.

The instant claims are met by the reference as the reference anticipates the instant claims at the lower limit of the recited range of the reference (i.e. from 0.05 up to 3 microns). While the reference does not recite that the composition is a cement setting accelerator it is well settled that when a claimed composition appears to be substantially

Art Unit: 1793

the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Specification No. JP 2001-233661 A in view of Lin (US Patent No. 5,518,980 A).

JP 2001-233661 teaches, in paragraph [0033]-[0034] the use of an accelerating admixture such as calcium hydroxide in an amount of from 0.3 - 1% based on 100 percent of the cement.

The secondary reference was discussed previously.

The instant claims are rendered obvious by the combination of references. The instant claims differ from the primary reference in that the primary reference does not recite the particle size of the calcium hydroxide. It would have been obvious to one of

Art Unit: 1793

ordinary skill in the art to utilize any size of calcium hydroxide such as the calcium hydroxide of the Lin reference without producing any unexpected results as applicant has not shown that the use of a specific particle size of calcium hydroxide produces unexpected results.

10. Claims 3-4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi et al (US Patent No. 4,650,523 A) in view of Lin (US Patent No. 5,518,980 A).

Kikuchi et al (US Patent No. 4,650,523 A) teaches, in the abstract, examples and the claims, a cement accelerating agent comprising calcined alunite, a carbonate and lime. According to column 3, lines 35+ the lime can be quicklime or slaked lime. The admixture is added to cement compositions.

The instant claims are rendered obvious by the combination of references. The instant claims differ from the primary reference in that the primary reference does not recite the particle size of the calcium hydroxide. It would have been obvious to one of ordinary skill in the art to utilize any size of calcium hydroxide such as the calcium hydroxide of the Lin reference without producing any unexpected results as applicant has not shown that the use of a specific particle size of calcium hydroxide produces unexpected results.

11. Claims 3-4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simeonov et al (US Patent No. 4,205,998 A) in view of Lin (US Patent No. 5,518,980 A).

Simeonov et al (US Patent No. 4,205,998 A) teaches, in the abstract, examples and the claims, a cement accelerating agent comprising dialuminum pentahydroxy-

Art Unit: 1793

chloride, calcium sulfate and calcium oxide which may be in the form of hydrated lime. Column 3, teaches that 2 parts of the lime may be added. The mixture is added to cement compositions.

The instant claims are rendered obvious by the combination of references. The instant claims differ from the primary reference in that the primary reference does not recite the particle size of the calcium hydroxide. It would have been obvious to one of ordinary skill in the art to utilize any size of calcium hydroxide such as the calcium hydroxide of the Lin reference without producing any unexpected results as applicant has not shown that the use of a specific particle size of calcium hydroxide produces unexpected results.

Information Disclosure Statement

12. The remaining references have been reviewed by the examiner and are considered to be cumulative to or less material than the references relied on above.

References Cited By The Examiner

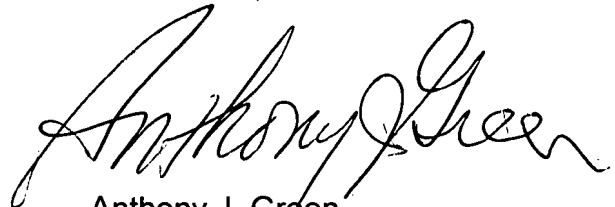
13. The remaining references have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Art Unit: 1793

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony J. Green
Primary Examiner
Art Unit 1793

ajg
October 3, 2007